

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN G. SAVAGE, JONATHAN S. BLACK
and KENNETH A. NICOLL

MAILED

JUL 21 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1368
Application No. 09/433,135

ON BRIEF

Before OWENS, LEVY and FETTING, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 43-52, which are all of the pending claims.

THE INVENTION

The appellants claim a method and a self-service terminal, such as an automated teller machine, for conducting an item dispensing transaction using spoken words. Claim 43 is illustrative:

43. A self-service terminal for allowing a user of the terminal to conduct an item dispensing transaction using spoken words, the terminal comprising:

means for creating at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user;

means for delivering the at least one audible prompt to the user;

means for receiving at least one word spoken by the user after the at least one audible prompt is delivered to the user;

means for determining if the at least one word received from the user corresponds to the at least one word provided by the terminal; and

means for dispensing an item to the user when the at least one word received from the user corresponds to the at least one word provided by the terminal.

THE REFERENCES

Paganini et al. (Paganini)	4,420,751	Dec. 13, 1983
Rabin	6,081,782 (filed Dec. 29, 1993)	Jun. 27, 2000

THE REJECTIONS

The claims stand rejected as follows: claims 43, 44 and 46-49 under 35 U.S.C. § 102(e) as anticipated by Rabin; claim 45 under 35 U.S.C. § 103 as obvious over Rabin in view of Paganini;¹ and claims 50-52 under 35 U.S.C. § 103 as obvious over Rabin.

OPINION

We reverse the rejections of claims 43-50 and 52, and affirm the rejection of claim 51.

*Rejection of claims 43, 44 and 46-49
under 35 U.S.C. § 102(e) over Rabin*

Rabin discloses a voice command control and verification system and method which stores, for each authorized user, one or a series of speech models of voice commands or phrases uttered by each authorized user (col. 2, lines 16-19). In a telecommunications system embodiment a user accesses the system by dialing a unique telephone number assigned to the user (col. 2, lines 39-45). In an automated teller machine (ATM) embodiment the user accesses the system by inserting an ATM card into an ATM machine (col. 3, lines 11-13). In either embodiment the system stores for each user a series of voice commands that can be recognized by a speech recognition system and can be used

¹ In the examiner's answer the examiner omitted the rejection of claim 45 from the grounds of rejection but included that claim in the response to arguments (page 3). We consider the examiner's omission of claim 45 from the grounds of

to verify the identity of the user by determining whether a command spoken by the user matches a stored command and, if so, whether the vocal characteristics of the same command match vocal characteristics stored for the user (col. 2, lines 42-55; col. 6, lines 57-65). A voice response unit (VRU) can play announcements such as voice prompts to the user for voice commands (col. 4, lines 56-67).

The examiner argues that Rabin's processor (201) that controls the ATM is a means for creating an audible prompt (answer, pages 3-4). The appellants' claims 43, 44 and 46-49, however, require more than a processor. Claim 43 requires means for determining if a user's word corresponds to a word provided by the terminal, and means for dispensing an item to the user when there is such a correspondence. Independent claim 48 includes comparable requirements limited to an ATM, and independent claim 46 requires that the audible prompt includes a question that can be answered by a positive or negative response, and requires means for determining whether a word spoken by a user answers the question.

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To establish a prima facie case of anticipation the examiner must point out where all of the claim limitations appear in a single reference. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). The examiner does not point out where the above-mentioned means required by the appellants' claims appears in Rabin. Accordingly, we reverse the rejection of claims 43, 44 and 46-49.

*Rejection of claim 45 under 35 U.S.C. § 103
over Rabin in view of Paganini*

The examiner does not rely upon Paganini for any disclosure that remedies the above-discussed deficiency in the examiner's argument with respect to Rabin (final rejection mailed October 25, 2004, pages 4-5). We therefore reverse the rejection of claim 45.

*Rejection of claims 50-52
under 35 U.S.C. § 103 over Rabin*

Claims 50 and 52 are method claims having limitations that correspond to the means limitations in, respectively, claims 43 and 46.

The examiner argues that it would have been obvious to one of ordinary skill in the art to provide Rabin's terminal with the ability to help a consumer by providing a prompt including a word

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to be spoken by the customer (e.g., for a deposit, say "deposit")
(answer, page 4).

In order for a prima facie case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The examiner does not point out where Rabin itself would have fairly suggested, to one of ordinary skill in the art, matching a word spoken by a user with a word provided by a terminal. Consequently, we reverse the rejection of claims 50 and 52.

Claim 51 is a method claim that requires determining whether a user's spoken word answers a question in an audible item dispensing prompt which can be answered by a positive or negative response.

The examiner finds that it was well known in the art for an ATM to ask whether a customer would like a receipt (answer, page 5). The appellants do not argue that the examiner's statement is incorrect but, rather, merely argue that the examiner has not cited a reference in support of the statement (brief, page 6). Because the examiner's statement is reasonable and has not been challenged by the appellants, we accept it as fact. See *In re Kunzmann*, 326 F.2d 424, 425 n.3, 140 USPQ 235, 236 n.3 (CCPA 1964). Thus, we conclude that Rabin's disclosure of voice prompts (col. 4, lines 55-65) would have fairly suggested, to one of ordinary skill in the art, a voice asking whether the user would like a receipt. The appellants argue that the examiner's argument does not relate to an item dispensing prompt (brief, pages 6-7). That argument is not persuasive because a receipt is an item.

For the above reasons we are not convinced of reversible error in the examiner's rejection of claim 51. Therefore, we affirm the rejection of that claim.

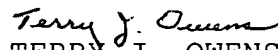


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DECISION

The rejections of claims 43, 44 and 46-49 under 35 U.S.C. § 102(e) over Rabin, claim 45 under 35 U.S.C. § 103 over Rabin in view of Paganini, and claims 50 and 52 under 35 U.S.C. § 103 over Rabin, are reversed. The rejection of claim 51 under 35 U.S.C. § 103 over Rabin is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(vii).

AFFIRMED-IN-PART

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TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	APPEALS
STUART S. LEVY)	AND
Administrative Patent Judge)	INTERFERENCES
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Administrative Patent Judge)	

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